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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,045	11/29/2001	Flemming Boegelund	AUS920010934US1	6053

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Intellectual Property Law Department
IBM Corporation
11400 Burnet Road
Austin, TX 75758

EXAMINER

BAYERL, RAYMOND J

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,045

Applicant(s)

BOEGELUND, FLEMMING

Examiner

Raymond J. Bayerl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 - 5, 11 - 15, 22 - 38 is/are rejected.
- 7) ☒ Claim(s) 6 - 10, 16 - 21 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

“The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words.”

Applicant's abstract deviates from these guidelines by comprising two paragraphs.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 3.a. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what applicant intends to be the invention, when claim 11 is recited as “using the length obtained in claim 10”. Claim 10 is not a parent claim in dependent claim format, so if claim 11 is intended as a dependent, what part of claim 10 is in fact incorporated by this reference? Applicant should compare claim 11 with comparable claim 21, which is actually a dependent of a parent claim in which “the length” is found.

- 3.b. Claims 30 – 37 are also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The pairs of claims: 30,34; 31,35; 32,36; 33,37 are identical. What is applicant's intention, in presenting such pairs of claims? Was, in fact, a difference between the members of these pairs intended?

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 – 5, 12 – 15, 22 – 29, 31, 33, 35, 37 are rejected under 35 U.S.C.

103(a) as being unpatentable over Kumar et al. ("Kumar"; US #6,356,921 B1) in view of Miller et al. ("Miller"; US #2004/0080525 A1).

As per independent claim 1's "appending information to a graphical image file" (see also independent claim 12), Kumar discloses that HIERARCHICAL AND ADAPTIVE DELIVERY RICH MEDIA PRESENTATIONS AND ASSOCIATED META DATA may be contained within a single file that contains all information for a complete presentation (Abstract). This presentation file can contain a file header frame and multiple media frames, and also a thumbnail description. In working with Media bit streams (col 9, lines 29 – 49), Kumar, beginning with JPEG frames (a "graphical image file of said created graphical image") will develop "an appendix to the graphical image file" that enables the additional presentation functionality, as in figs 1, 6A, 7.

Kumar's file structure is described in general terms relating to object linking within a rich media environment (col 2, lines 7 – 31), and does not enter into a depth of discussion such as "defining an area on the created image as a hotspot area". However, Miller's OBJECT SELECTION USING HIT TEST TRACKS is specifically directed to producing a selected visual area (Abstract; fig 2b) that is linked to at least

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one image frame, the resultant information being stored within a labeled portion of memory.

Thus, it would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to code a "hotspot" with the hit test track of Miller (see also paragraph 0020), within the single file arrangement of Kumar's presentation, so that regions within Kumar's rich media might be made precisely controlled as to how they are linked to other information resources.

As per claims 2, 13 "appending the generated appendix" is part of the general single file arrangement in Kumar, as is the incorporation of "a JPEG file format" (claim 5), as noted above.

Claim 3's use of "an image creation tool" (this also being claim 4's "external tool"; see also claims 14, 15, 23) is specifically a part of Miller's labeling the pixels: via pattern recognition techniques or through manual object tracking (paragraph 0033).

Independent claim 22 is broader, in that merely "an image extension" is used, for "appending image definition information" that is recovered by "an image extension decoder module". However, Kumar continues to suggest that "an image file of an image" be made into "an extended image file", as in the single file. The "extension" to include "image definition information" is then suggested by the obvious combination with Miller, where defined imagery is made part of the labeling.

The "hotspot definition information" of claim 24 is to be seen in the ability to support OBJECT SELECTION in Miller, while Kumar specifically teaches a presentation, as in claim 25's "presentation slide program". Claim 26's "capability to

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create image information definitions”, meanwhile, is found in Miller’s labeling tools, as noted above with respect to claim 3, with an “image file module as part of said image generating tool” that produces the hit test track (claim 27) with “image hotspot definition information” (claim 28). Such a “tool” is clearly “a graphics software program” (claim 29).

Within the playback of Miller, “said decoder module is a special purpose program within a computing machine” (claims 31, 35), and in Kumar, the comparable routines are for “navigation and display” throughout the presentation (claims 33, 37).

6. Claims 30, 32, 34, 36, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumar in view of Miller and Ramos et al. (“Ramos”; US #2002/0196272 A1).

While various browsing and playback adaptations must be used in the combination of Kumar/Miller, these do not extend to the point of “a plugin program contained in a webBrowser module” (claims 30, 34), “navigation and display program” adaptations within such a “module” (claims 32, 36) or “a native webBrowser that has been enhanced to perform the decoding” (claim 38).

However, Ramos discloses a specialized INTERNET BROWSER that can interpret SMART IMAGES with a digital watermark (Abstract). When given an image so annotated, Ramos is capable of picking off the indicia and acting accordingly.

Thus, it would also have been obvious to the person having ordinary skill in the art at the time of applicant’s invention to use a modified “webBrowser” as per Ramos to handle the Kumar presentation in a single file that contains extensions as per Miller,

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since this allows the image a more straightforward recognition and interpretation at the receiving end.

7. Claims 6 – 11, 16 – 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Please note also that the above-noted uncertainty under 35 USC 112 must be rectified, concerning claim 11.

The best prior art of record, namely Kumar in view of Miller, suggests that a “hotspot area” be made part of an “appendix to the graphical image file”, as outlined above. However, such prior art does not teach or suggest all of the “appendix generation” that occurs in claims 6, 16, especially the use of “the length of the graphical image file” as appended “to the end of said new file”, and thus would be allowed over the art of record, if placed in independent claim form.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The remaining US Patent documents made of record (see attached form PTO-892) relate to the linking of imagery and external information resources.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (703) 305-9789 through the month of October 2004 and (571) 272-4045 thereafter. The examiner can normally be reached on M - F from 10:00 AM to 5:00 PM ET.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703) 308-3116 through the month of

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October 2004 and (571) 272-4048 thereafter. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (703) 872-9306.

11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173
28 September 2004